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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,255	03/23/2000	SADAFUSA TSUJI	15162/01700	9075
24367	7590	11/28/2007	EXAMINER	
SIDLEY AUSTIN LLP			VIG, NARESH	
717 NORTH HARWOOD			ART UNIT	
SUITE 3400			PAPER NUMBER	
DALLAS, TX 75201			3629	
			MAIL DATE	DELIVERY MODE
			11/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/534,255

Applicant(s)

TSUJI ET AL.

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 - 19, 21 - 24 and 26 - 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12 - 19, 21 - 24 and 26 - 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is in reference to response received 03 October 2007. Claims 12 – 19, 21 - 24 and 26 – 28 are pending for examination.

Response to Arguments

Applicant's arguments and concerns have been responded to in response to the pending claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 – 17, 18, 19, 21 – 23, 24, and 26 – 28 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 12 – 18, applicant has not positively claimed:

Whether user makes a selection from the list provided to the user to make a selection from, or, user makes a random selection.

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Whether the casting of account is adding charges to the account for the data written on the storage medium, or, it is a counter that is incremented every time specified data is recorded on the storage medium and decremented every time the specified data is deleted from the storage medium.

If casting of account is adding charges, does the user ever settle the charges to the casted account.

Is user's storage medium ever returned to the user.

As to claims 19, 21 – 24 and 26 - 28, applicant has not positively claimed:

Whether the user makes a selection from the display information

Whether the user command is same as a selection or it is a command like write, delete etc.

Whether the use is afforded a choice to accept or reject the data written on the storage medium.

Is the user forced to accept the data written, if not, then does the user lose their storage medium because the user has not accepted the data written on the storage medium.

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Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12 – 18, 19, 21 – 23, 24 and 26 – 28 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention does not deem to be useful because, the storage medium supplied by the user is not returned to the user unless user accepts the data written on the storage medium. As for claims 12 –18, user is not returned their supplied storage medium, i.e. user loses their supplied storage medium when they use applicant's invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato Japanese Publication JP 08-077455 A in view of Horstmann US Patent 6,009,401.

Regarding claim 12, as best understood by examiner, Sato teaches data distributing system. Sato teaches

a storage section which stores a plurality of pieces of data [Sato, Fig. 2 and disclosure associated with Fig. 2];

a receiving section which receives a storage medium [Sato, Fig. 2 and disclosure associated with Fig. 2];

a selecting section configured to accept user's selection of a specified piece of data from the data stored in the storage section [Sato, Fig. 2 and disclosure associated with Fig. 2];

a recording section which records the specified data into the storage medium [Sato, Fig. 2 and disclosure associated with Fig. 2];

Sato does not teach an accounting section which casts an account for the data recorded into the storage medium. However, Horstmann teaches accounting section which casts an account for data recorded into the storage medium.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato as taught by Horstmann to implement license management capability for controlling software downloads and installations.

Sato in view of Horstmann teaches having capability for:

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a reading section which reads at least part of the specified data recorded into the storage medium [Horstmann Fig. 3 and disclosure associated with Fig. 3];

a display section that displays information based on the data read out by the reading section to query a user for acceptance or rejection of the specified data recorded in the storage medium;

a deleting section which deletes the specified data from the storage medium configured to accept user's selection of in response to a user input indicating that the specified data recorded in the storage medium is rejected by the user [Sato, Fig. 11 and disclosure associated with Fig. 11, Horstmann Fig. 3 and disclosure associated with Fig. 3]; and

an account adjusting section which adjusts the account in accordance with the data deletion performed by the deleting section [Horstmann Fig. 3 and disclosure associated with Fig. 3].

Regarding claim 18, as best understood by examiner and as responded to earlier, Sato teaches method for recording data selected from a plurality of pieces of data into a storage medium [Sato, Fig. 2 and disclosure associated with Fig. 2] and deleting the recorded data [Sato, Fig. 11 and disclosure associated with Fig. 11]. Sato teaches:

selecting a specified piece of data from the plurality of pieces of data; recording the specified data into the storage medium [Sato, Fig. 2 and disclosure associated with Fig. 2];

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Sato does not teach casting at least one account for the specified data. However, Horstmann teaches accounting for an account for data recorded into the storage medium.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato as taught by Horstmann to implement license management capability for controlling software downloads and installations.

Sato in view of Horstmann teaches having capability for:

reading at least part of the specified data recorded in the storage medium [Sato, Fig. 2 and disclosure associated with Fig. 2];

displaying information based on the read data to query a user for acceptance or rejection of the specified data recorded in the storage medium;

deleting the specified data from the storage medium when the specified data recorded in the storage medium is rejected by the user [Sato, Fig. 11 and disclosure associated with Fig. 11, Horstmann Fig. 3 and disclosure associated with Fig. 3; and

adjusting the at least one account in accordance with the data deletion [Horstmann Fig. 3 and disclosure associated with Fig. 3].

Regarding claim 13, as responded to earlier, Sato in view of Horstmann teaches receiving section, the reading section, the selecting section and the recording section is connected to an apparatus which comprises the storage section by a communication line.

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Regarding claim 14, as responded to earlier, Sato in view of Horstmann teaches communication line is at least one of a telephone line and a communication satellite (applicant is claiming transmission of data over telephone line and a communication satellite as their claimed invention).

Regarding claim 15, as responded to earlier, Sato in view of Horstmann teaches, capability wherein the data read out by the reading section is about a date and time where the specified data were recorded into the storage medium (applicant is claiming reading data and time of the recorded data as their claimed invention. Commercially available Operating System like DOS, MS-Windows etc. teach capability for recording and reading date and time associated with recorded data).

Regarding claim 16, as responded to earlier, Sato in view of Horstmann teaches capability for a control section which inhibits the deleting section from deleting the specified data on and after passage of a specified time from the recording date and time (applicant is claiming not accepting a return from the customer after the expiration of the return period as their claimed invention. For example, department stores are known to implement return policies like return within 7 days, 30 days, All sales are final etc.)

Regarding claim 17, as responded to earlier, Sato in view of Horstmann teaches capability wherein the specified data are book data (applicant is claiming content of data stored on the storage medium as their claimed invention).

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Claims 19, 21 - 23, 24 and 26 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato Japanese Publication JP 08-077455 A in view capability and tools provided with operating systems like Windows NT 4.0 by Microsoft Corporation hereinafter known as Microsoft.

Regarding claims 19 and 24, as best understood by examiner and as responded to earlier, Sato teaches a means and method for using a data distributing system. Sato teaches:

a storage section which stores a plurality of pieces of data [Sato Fig. 2 and disclosure associated with Fig. 2];

a receiving section which receives a user supplied storage medium [Sato Fig. 2 and disclosure associated with Fig. 2];

a display section which displays information identifying each of the data stored in the storage section [Sato Fig. 2, 10 and disclosure associated with Fig. 2, 10];

an inputting section which allows the user to input a command [Sato Fig. 2 and disclosure associated with Fig. 2];

a selecting section which selects a specified piece of data in accordance with the command that the user inputs based upon the information displayed on the display section [Sato Fig. 2 and disclosure associated with Fig. 2];

a recording section which records the selected piece of data into the storage medium [Sato Fig. 2 and disclosure associated with Fig. 2]; and

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Sato teaches capability for ejecting the storage medium. Sato does not explicitly teach a prohibiting section which inhibits the storage medium from being ejected from the receiving section until the user inputs the command that the recorded data is acceptable. However, Microsoft teaches capability for prohibiting ejection of storage medium like CDROM while it is in use.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato as taught by Microsoft to prevent premature ejection of storage medium.

Sato in view of Microsoft does not explicitly teach ejection of storage medium after user inputs the command that the recorded data is acceptable (i.e. receiving acknowledgement from user that the transaction can be closed). However, it is old and known to one of ordinary skill in the art to complete the transaction after receiving an acknowledgement from the user. For example (in the instant invention, ejection of the storage medium after receiving the acknowledgement from the user is the indication that the user has accepted to complete the transaction. For example, during online transaction, user is prompted "Are You Sure" to receive user's acknowledgement that they have accepted the transaction to be completed.

Sato in view of Microsoft teaches capability for displaying information based on the recorded data in the storage medium to query the user for acceptance or rejection of the recorded data.

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Regarding claims 21 and 26, as responded to earlier, Sato in view of Microsoft teaches capability for having means which erases the recorded data from the storage medium when the user inputs the command that the recorded data is not acceptable (applicant is claiming retraction of user order as their claimed invention).

Regarding claims 22 and 27, as responded to earlier, Sato in view of Microsoft teaches capability for having means for reading at least part of data stored in the storage medium which is set in the receiving section, said selecting section selects the specified piece of data from the data stored in the storage section in accordance with the data read out by the reading section, and the recording section recording the selected data into the storage medium (e.g. replacing data, copying data etc.) [Sato, Fig. 11 and disclosure associated with Fig. 11].

Regarding claims 23 and 28, as responded to earlier, Sato in view of Microsoft teaches capability for storing a plurality of pieces of book data (applicant is claiming content of data as their claimed invention) and said display section displays index information about the book data stored in the storage section (old and know that Microsoft has capability of displaying data stored on storage medium, e.g. 'dir' command).

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Conclusion

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig
Examiner
Art Unit 3629

November 25, 2007